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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,900	07/02/2003	John D. McEnroe JR.	MCEJ101.CIP	6838
21261	7590	09/21/2005	EXAMINER	
ROBERT PLATT BELL P.O. BOX 310 AURORA, NY 13026			SAFAVI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3673	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/613,900	MCENROE, JOHN D.	
	<b>Examiner</b>	<b>Art Unit</b>	
	M. Safavi	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) 4,7,8,12,14,17-19 and 22-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 9-11, 13, 15, 16, 21, and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/2/03; 2/2/04</u> .  | 6) <input checked="" type="checkbox"/> Other: <u>IDS of 5/10/04</u> .       |

### ***Election/Restrictions***

Applicant's election without traverse of the species of suspension assembly shown in Fig. 5 and the species of connecting member/form shown in Fig. 40/41/42 and the species of form shape shown in Fig. 2 in the reply filed on May 23, 2005 is acknowledged.

Claims 4, 7, 8, 12, 14, 17-19, and 22-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of the invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 23, 2005.

### ***Information Disclosure Statement***

The information disclosure statement filed May 10, 2004 fails to fully comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Applicant has failed to provide a date of publication, (or a date of public access), for the reference(s) listed under 'Other Documents'. It has been placed in the application file, but the information referred to therein, with respect to the reference(s) listed under 'Other Documents', has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Further, it is not clear if Applicant is listing a single reference under Other Documents' or multiple references. The three lines appear to refer to FAST-TUBE™ but it is not clear if the three lines are referring to one, two, or three separate documents.

### ***Specification***

The substitute specification filed January 11, 2005 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: the substitute specification presents a number of discrepancies within the specification as well as between the specification and drawings. For example, numeral 5 is used to denote a fence post while depicting a dotted circle representing a blow-up section. Numeral 14 is used to denote an element 14 of the invention while depicting a dotted circle representing a blow-up section. Numeral 314 is used to denote a "tubular segment" while numeral 31 depicts a "tubular segment". These are merely examples of discrepancies throughout the specification. Applicant should review the entire specification to ensure appropriate use of reference characters.

### ***Drawings***

The drawings were received on January 11, 2005. These drawings have not been entered. The proposed drawings present reference numerals as depicting multiple elements of the invention. For example, numerals 31, 312, and 314 are used to depict a tubular segment. Numeral 5 is used to depict a fence post while depicting a dotted circle representing a blow-up section. These are merely examples of discrepancies

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throughout the proposed drawings. Applicant should review the entire specification along with drawings to ensure appropriate use of reference characters.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5, 6, 9-11, 13, 15, 16, 21, and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification had not originally presented a "*non-rigid... tubular segment which is foldable and rollable upon itself in any axis*" as is now recited in each of claims 1 and 10 nor a "*non-rigid, non-structural... tubular segment which is foldable and rollable upon itself in any axis*" as is now recited in claim 29. The specification had not originally presented a polymer material having "a thickness ranging from 0.1 to less than 0.2 millimeters" as is now presented in each of claims 2 and 13.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 6, 13, 15, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, line 4, to what suspension assembly connector does “a suspension assembly connector” refer? Would this be the same suspension assembly connector presented at line 3 of claim 5?

Claim 6, line 4, to what suspension assembly connector does “a suspension assembly connector” refer? Would this be the same suspension assembly connector presented at line 3 of claim 6?

Claim 15, line 4, to what suspension assembly connector does “suspension assembly connector” refer? Would this be the same suspension assembly connector presented at line 3 of claim 15?

Claim 16, line 3, to what suspension assembly connector does “suspension assembly connector” refer? Would this be the same suspension assembly connector presented at line 2 of claim 16?

Further, each of claims 5, 6, 15, and 16 recites, “...wherein the form suspension assembly further comprises” when claims 1 and 10 do not set forth that the form suspension assembly comprises any particular element.

Claim 13, line 2, to what does “sheet polymer material” refer?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Grafton '206.**

Grafton '206 discloses a pliable tubular segment 5 formed of a polymer material with a form suspension assembly 19/20 serving to hold the tubular segment to a form support member 23.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 5, 6, 10, 13, 15, 16, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grafton '206 in view of Lafleur '482.**

Grafton '206 discloses a pliable tubular segment 5 formed of a polymer material with a form suspension assembly 19/20 serving to hold the tubular segment to a form support member 23. A suspension assembly connector is at 20 with support arm at 19 and support ring 18 supported by the support arm 19 and attached to the tubular segment 5. Grafton does not appear to specifically disclose a tubular segment having a thickness of substantially 0.1 to 0.2 millimeters.

However, Lafleur '482 discloses forming a polymeric bag or liner of a thickness on the order of 4-10 millimeters, col. 1, line 18. Therefore, to have formed the Grafton tubular segment 5 of a thickness on the order of 0.1-0.2 millimeters, thus providing a durable tubular segment form, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Lafleur '482.

**Claims 1, 9-11, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turzillo '989 in view of Grafton '206 when considering Lafleur '482.**

Turzillo '989 discloses, Fig. 26, a pliable tubular segment 55 with a form suspension assembly 60 serving to hold the tubular segment to a form support member 59. A form positioning and dampening assembly attachable to the form support member and a surface is at 59b or is at the lower most portion of the tubular segment. Turzillo does not appear to specifically disclose a tubular segment formed of a polymer material having a thickness of substantially 0.1 to 0.2 millimeters.



However, Grafton '206 teaches a form 5 of polymer material while Lafleur '482 discloses forming a polymeric bag or liner of a thickness on the order of 4-10 millimeters, col. 1, line 18. Therefore, to have formed the Turzillo tubular segment 55 of a polymer material having a thickness on the order of 0.1-0.2 millimeters, thus providing a durable tubular segment form, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Grafton '206 when considering Lafleur '482.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (571) 272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



**MICHAEL SAFAVI**  
**PRIMARY EXAMINER**  
**ART UNIT 354**

M. Safavi  
August 05, 2005